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EXAMINER				
WRIGHT, PATRICIA KATHRYN				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/502,130

Applicant(s)

ZIEGLER, MICHAEL

Examiner

P. Kathryn Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 24-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 and 24-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 1/9/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to papers filed January 09, 2008 in which claims 1, 4 were amended, claims 5-23 were canceled, and claim 24-35 were added. The amendments have been thoroughly reviewed and entered. New claims 24-33 essentially correspond to previously presented claims 5-18 and new claims 34-35 essentially correspond to previously presented claim 19.

The previous rejections in the Office Action dated July 06, 2007 are withdrawn in view of the amendments. Applicant's arguments have been thoroughly reviewed but are deemed moot in view of the amendments, withdrawn rejections, and new grounds for rejection. The new grounds for rejection was necessitated by the amendments, namely, the new recitation "the chamber being in a container", and the incorporation of the limitations from both previously claims 6 and 7 into instant claim 1, thereby changing its scope. Note that previous claims 6 and 7 depended directed from previous claim 1.

Claims 1-4 and 24-35 are under prosecution.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "chamber being in a container" in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 24-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites "said chamber being in a container". Applicant's specification defines the "the chamber" as element 16 in which the image recording device 30 and scanner 29 are accommodated (see for example page 7, lines 9-12). The container 20 is defined as containing body fluid 21 (see for example page 6, lines 18-32). There is no support in the instant specification (including the figures) for the "chamber 16 being in a container". Nor has Applicant pointed out where support for such a configuration can be found in the specification and/or figures.

In addition, the Examiner cannot locate support for the chamber being in a container and with not optical reflections as recited in claim 3.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 and 24-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 now recites "said chamber being in a container". This is confusing and indefinite. As discussed above, the specification defines "the chamber" as element 16 in which the image recording device 30 and scanner 29 are accommodated (see for example page 7, lines 9-12). The container 20 is defined as containing body fluid 21 (see for example page 6, lines 18-32). As discussed above, there is no support for the

"chamber being in a container" in the specification and/or figures. Thus, it is not clear what "chamber" Applicant is referring to in claims 1 and 3. For the same reasons discussed above, it is not clear how the chamber inside the container has not optical reflections as recited in claim 3. For purposes of examination, the body fluid will be interpreted as being provided in a container.

Claim 1 also lacks any transitional phrase (e.g., comprising, consisting essentially of, and consisting of) that separates the claim preamble and body of the claim. Transitional phrases define the scope of the claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. As presently written it appears the claim is directed to the illuminating device. The "chamber", "container", "image recording device" and "electronic image evaluation apparatus" are not positively recited elements of the claim. For the purposes of examination, the claim has been interpreted to be directed solely to the particular arrangement of the illuminating device.

Claims 1-4 and 24-35 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: between the "image recording device" and the "illuminating device". It is not clear how these two elements are related.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 25, 27, 29 and 34, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Russell (US Patent No. 5,012,116).

Russell teaches an arrangement for analyzing items (i.e., ball bearings 202) using an illumination device arranged above and illuminating an item (i.e., light diffusing cylindrical tube 204). Note that the container (and chambers) are not positively recited elements of the claim and therefore, do not patentability distinguish the device. Therefore, the ball bearings 202 of Russell read on the container and chamber.

The illumination device of Russell includes two lateral lamps 222a,b and a middle lamp 222c. The two lateral lamps are disposed on each side of the container such that the mid-points of the two lamps and the mid point of the container lie on a straight line (see horizontal line in Fig. 2a). The middle lamp 222c is disposed in such a way that the mid point of the middle lamp and the container lie on a straight line see vertical line in Fig. 2a, which is perpendicular to the straight line the horizontal line.

Note although, not positively recited in the instant claims, Russell also teaches an image-recording devices 120 (video camera 218a) see Fig. 2a.

Regarding claim 29, the other video camera 218b in Fig. 2a reads on a "scanner", since Russell teaches one of the image-recording devices can be a scanning video camera (see col. 4, lines 44-49).

As to claim 34, Russell also teaches a handling apparatus 200a,b (track rails) for moving a container from its transportation position (hopper 208) to its analysis position shown in Fig. 2a.

8. Claims 1-4, 24-25, 27, and 29, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Chandler (US Patent No. 6,139,800).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Chandler teaches an apparatus for use in assays. The apparatus includes a lateral lamp 12, 16 arranged on both sides of a container 1 (see Fig. 4). The arrangement being such that the mid-points of the two lamps and the mid-point of the container lie on a straight line (A). See figure 4 of Chandler. Furthermore, a middle lamp 14 is provided and arranged in such a way that the mid points of this middle lamp and of the container, likewise, lie on a straight line (B), which runs perpendicular to the line (A).

With respect to claims 24-25, Chandler teaches the optical axis of the image recording device 10 runs in a vertical plane that is perpendicular to the line (A). The line

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(B) lies in this vertical plane, see Fig. 4. Please note that Chandler teaches that laser diodes are preferred, however, other optical sources/detectors are suitable.

Regarding claim 29, one of the optical detectors 20, 22, reads on a "scanner", since optical detectors can be used to scan an item.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 26 and 28, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell (US Patent No. 5,012,116) or Chandler (US Patent No. 6,139,800).

The teachings of Russell and Chandler have summarized previously, *supra*. Neither Russell or Chandler specifically recite the spacing of each lamp from the

container being sixty millimeters (claim 26) or the difference in height between the lateral lamps and the middle lamp is sixteen millimeters (claim 28).

However, it would have been an obvious matter of design choice to make the spacing between each lamp from the container sixty millimeters and the difference in height between the lateral lamps and the middle lamp sixteen millimeters, in the either system of Russell or Chandler, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

12. Claims 30, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell (US Patent No. 5,012,116) or Chandler (US Patent No. 6,139,800), in view Watson et al., (WO 99/28724), hereinafter Watson.

The teachings of Russell and Chandler have been summarized previously, *supra*. While both references teach a scanner, neither teach a bar code scanner. However, the use of bar code scanners to identify items being analyzed is considered conventional in the art, see for example Watson.

As discussed in the previous Official action, dated July 06, 2007, Watson teaches an arrangement for analyzing body fluids having an imagine- recording device 22 (color image digital camera) connected to an electronic image evaluation apparatus (controller, not shown) and a barcode scanner 20. The body fluid is provided in container 14 inside a chamber 10 believed to have few optical reflections provided by the bias in the variation in brightness of the illumination means 142. In the analysis

position, the image recording device is aligned with and focused on the container, and an illuminating devices 142 for illuminating the container from above and below.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have replaced the scanner of Russell or Chandler with the bar code scanners, since bar code scanners are well known in the art for providing reliable means for automatically identifying items being analyzed.

13. Claims 31-33, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell (US Patent No. 5,012,116) or Chandler (US Patent No. 6,139,800), in view of Toshiaki (JP 09-133687).

The teachings of Russell and Chandler have summarized previously, *supra*. Russell and Chandler do not recite an anti-reflection plate arranged on the side of the container and turned away from the image recording device.

Toshiaki does teach an anti-reflection plate (plastic body or piece of paper) made of a white or gray material placed behind the tube when the image is recorded, in order for the background to be as uniform as possible and arranged on the side of the container, turned away from the image recording device, see paragraph [0042] of Detailed Description section of Toshiaki (see English translation provided with Official action dated July 06, 2007). The flexible paper is believed capable of creating a concave depression adapted to conform to the peripheral shape of the container. It is obvious to a person skilled in the art that is measure is most effective if the material is in direct contact with the label, not only along a line of contact but over entire rounded surface of the container. Furthermore, it would have been obvious to the skilled artisan that the

material not have a visually disruptive, abrupt structure, even in places where it is not lying flat.

With respect to claim 33, the anti-reflection material is arranged such that it "can be" moved away from the container by a person. Note that the method of using holds no patentable weight in an apparatus claim. Only structural language is determinative of the metes and bounds of a patent apparatus claim. Functional recitations, standing alone, while perhaps helpful in understanding the meaning of a claim and the invention that it represents, cannot be relied upon to distinguish over the prior art. Nevertheless, functional language in the claims must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language. However, an applicant must establish that what is expressly taught by the prior art does not inherently function in the manner required by the claim.

Furthermore, with respect claim 33, it has been held that the recitation that an element "can" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to have included in Russell or Chandler, the specific optical and detector configuration taught in Toshiaki in order to provide an anti-reflection plate to make the exterior of the tube as uniform as possible to remove the background noise resulting from a tube with or without label.

14. Claims 35, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell (US Patent No. 5,012,116) in view Watson et al. (WO 99/28724), hereinafter Watson.

As discussed above, Russell does teach a handling apparatus 200a,b (track rails) for moving a container from its transportation position (hopper 208) to its analysis position shown in Fig. 2a, Russell does not specifically recite the handling device comprising a lifting rotary gripper.

However, the use of a lifting rotary gripper for transporting items being analyzed is considered conventional in the art, see for example Watson.

As discussed in the previous Official action, dated July 06, 2007, Watson teaches an arrangement for analyzing items comprising a pair of rotating grippers 146 capable of holding the item at a predetermined angle so that the camera can more readily capture images of the item being analyzed.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the analysis system of Russell the lifting rotary gripper of Watson, since rotary gripper are well known in the art to position the analysis item at a predetermined angle that permits the camera to more easily capture images of the item being analyzed.

Response to Arguments

15. Applicant's arguments with respect to claims 1-4, 24-35 have been considered but are moot in view of the new ground(s) of rejection. See above.

Conclusion

16. No claims allowed.
17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797